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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,290	09/09/2003	Kazuo Fujita	018995-737	1381

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EXAMINER

SCHILLING, RICHARD L

ART UNIT PAPER NUMBER

1752

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4)

<b>Office Action Summary</b>	<b>Application No.</b> 10/657,290	<b>Applicant(s)</b> FUJITA, KAZUO	
	<b>Examiner</b> Richard L. Schilling	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                     |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                         | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9-09-03 12-12-03</u> | 6) <input type="checkbox"/> Other: ____.                                                |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishioka et al. Nishioka et al. (see particularly column 2, lines 16-40; column 8, lines 25-68; column 7, lines 18-41) disclose presensitized lithographic printing plates comprising light sensitive layers containing surfactants of copolymers with perfluoro-alkyl acrylate comonomers within the scope of Formula 1 of instant claim 1 and comonomers containing

polyoxyalkylene within the scope of Formula II of instant claim 5 when R" is the sulfonamide group and n is 3 or 4 in the formula on column 8, lines 45-55 of Nishioka et al. The sulfonamide group is used in 20 out of 21 working examples for the copolymers in Nishioka et al. While the perfluoroalkyl group in Nishioka et al. is disclosed as preferably having at least 6 carbon atoms, Nishioka et al. still discloses that the perfluoroalkyl group includes those with 3 carbon atoms as specifically set forth on column 7, lines 34-41. Therefore, it would at least be obvious to one skilled in the art to use perfluoroalkyl groups in Nishioka et al., in combination with the sulfonamide groups for R", having 3 or 4 carbon atoms in the perfluoroalkyl groups.

2. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adachi et al. '922. Adachi et al. '922 (see particularly column 3, line 48 - column 5, line 21; monomers V-3, 4, 21; column 10, lines 10-65) discloses presensitized lithographic printing plates with light sensitive layers containing copolymer surfactants with perfluorinated alkyl acrylate monomers within the scope of Formula I of instant claim 1 and with preferably comonomers of Formula VI in Adachi et al. within the scope of Formula II of instant claim 2. Monomers V-3, 4 and 21 in Adachi et al. are within the scope of Formula I of

the instant claims. Specifically disclosed monomers 3, 4 and 21 of Adachi et al. in combination with the preferred acrylate comonomers of Formula VI of Adachi et al. puts one skilled in the art in the possession of copolymers as set forth in the instant claims. Alternatively, it would at least be obvious to one skilled in the art to use surfactant copolymers of Adachi et al. with the preferred comonomers of Formula VI with monomers 3, 4 and 21 within the scope of Formula V of Adachi et al.

3. The comparisons in the specification are noted but are unconvincing. The comparisons are not with the closest prior art of Nishioka et al. which is the copolymer in working Example 19 having 6 carbon atoms in the fluoroalkyl group. Also, the comparisons in the specification do not show the criticality of selecting both perfluoroalkyl sulfonamide and 1 to 4 carbon atoms in the fluoroalkyl group since the comparison compounds have 8 carbon atoms in the fluoroalkyl group for acrylate monomers with and without the sulfonamide. The results in the specification show that 2 to 4 carbon atoms in the fluoroalkyl group provide better results than 8 carbon atoms whether or not the sulfonamide is present. Nishioka et al. clearly discloses that their fluoroalkyl groups may contain 3 carbon atoms specifically set forth, for example, on column 7, lines 34-36, even though it is not preferred. In Adachi et al. '922 fluoroalkyl monomers with

and without sulfonamide groups are also disclosed and monomers with fluoroalkyl groups with less than 4 carbon atoms as required by the instant claims are specifically disclosed both with and without the sulfonamide groups. It would at least be obvious to one skilled in the art to use the fluoroalkyl monomers of Adachi et al. '922 with 4 or less carbon atoms in the fluoroalkyl groups in combination with the polyoxyalkylene preferred monomers of Adachi et al. in the disclosed copolymer surfactants. The comparisons in the specification are also unconvincing since they are not commensurate in scope with the claimed subject matter. The comparisons are limited to using comonomers with the preferred 2-4 carbon atoms in the fluoroalkyl groups and with "X" of Formula I being oxygen. The comonomers used in the comparisons in the specification are also limited to those containing polyoxyalkylene monomers within the scope of Formula II on page 15 of applicants' specification wherein Y has the preferred 2-4 carbon atoms and Q is the preferred value of 3-30. Also, the comparisons are limited to using copolymers of Formula II wherein "X" is oxygen.

4. Adachi et al. is cited of interest in the art as disclosing light sensitive compositions with copolymer surfactants of polyoxyalkylene and fluorinated alkyl acrylate. Fujita et al. is cited of interest in the art as disclosing light

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sensitive lithographic printing plates comprising copolymers with fluoroalkyl acrylate monomers F-47 and F-48 within the scope of the comonomers set forth in the instant claims. Suzuki et al. is cited of interest in the art as disclosing comonomer surfactants substantially cumulative to those set forth in Nishioka et al. The prior art submitted by applicants has been considered.

5. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

February 23, 2005

RECEIVED  
FEBRUARY 24 2005  
GROUP 4100

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*[Signature]*